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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,492	09/24/2003	William Brown Farnham	SR0021USNA	6800

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WILMINGTON, DE 19805

EXAMINER

LEE, SIN J

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/669,492	Applicant(s) FARNHAM ET AL. S.C.	
	Examiner Sin J. Lee	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-26 is/are allowed.
- 6) ☒ Claim(s) 1,6-8 and 11 is/are rejected.
- 7) ☒ Claim(s) 2-5,9,10,12 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02232004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 12 is objected to because of the following informalities: the claim dependency of present claim 12 should be changed from "claim 6" to --- claim 11 ---. Appropriate correction is required.

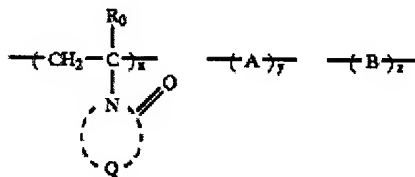
Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 6-8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabuuchi (5,945,267).

Yabuuchi teaches a silver halide color *photographic light sensitive* material comprising a support having thereon *photographic component* layers including a silver halide emulsion layer, at least one of the component layers containing a coupler of his invention (see col.1, lines 51-52, col.2, lines 1-22). Yabuuchi furthermore teaches (col.24, lines 40-67, col.25, lines 1-28) that the component layer containing the coupler preferably further contains a polymeric compound having a repeating unit represented by the following formula:



in which A and B each represents an ethylenic unsaturated compound which is copolymerizable. As one of the examples for the ethylenic unsaturated compound, Yabuuchi teaches N-(1,1-dimethyl-3-hydroxybutyl)methacrylate. Therefore, it would have been obvious to one of ordinary skill in the art to use the monomer of N-(1,1-dimethyl-3-hydroxybutyl)methacrylate to form the repeating unit of "A" in the formula shown above with a reasonable expectation of obtaining a silver halide photographic light sensitive material having high sensitivity and low fog and superior storage stability. The monomer of N-(1,1-dimethyl-3-hydroxybutyl)methacrylate teaches present formula of claims 1 and 6 (present X would be a methyl group, present R¹ and R² would both be methyl groups, present R³ and R⁴ would be H atoms, present n would be 1, present R⁵ would be H atom, and present R⁶ would be a methyl group). Therefore, the prior art's teaching would render obvious present inventions of claims 1 and 6.

With respect to present claims 7 and 8, Yabuuchi also includes halogenated olefin (e.g., vinyl chloride) among those examples for his ethylenic unsaturated compound that makes up those repeating units "A" and "B". Therefore, it would have been obvious to one of ordinary skill in the art to use the monomer of N-(1,1-dimethyl-3-hydroxybutyl)methacrylate to form the repeating unit of "A" in the formula shown above and furthermore use the monomer of vinyl *fluoride* (because there are only four halogen atoms) to form the repeating unit of "B" with a reasonable expectation of obtaining a

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silver halide photographic light sensitive material having high sensitivity and low fog and superior storage stability. Therefore, the prior art's teaching would render obvious present inventions of claims 7 and 8.

With respect to present claim 11, Yabuuchi also includes methyl acrylate among those examples for his ethylenic unsaturated compound that makes up those repeating units "A" and "B". Therefore, it would have been obvious to one of ordinary skill in the art to use the monomer of N-(1,1-dimethyl-3-hydroxybutyl)methacrylate to form the repeating unit of "A" in the formula shown above and furthermore use the monomer of methyl acrylate to form the repeating unit of "B" with a reasonable expectation of obtaining a silver halide photographic light sensitive material having high sensitivity and low fog and superior storage stability. Therefore, the prior art's teaching would render obvious present invention of claim 11.

Allowable Subject Matter

4. Claims 2-5, 9, 10, and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Yabuuchi's polymer does not contain a fluoroalcohol group or a protected fluoroalcohol group as presently required in claim 2. Yabuuchi's polymer also does not contain the present hydroxyl ester functional group of PinAc or PinMAc as in present claim 5. Yabuuchi does not teach or suggest present repeat unit of claim 9 derived from a polycyclic ethylenically unsaturated compound. Yabuuchi does not teach or suggest present repeat unit derived from NB-F-OH as in claim 13.

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5. Claims 14-26 are allowed. Yabuuchi does not teach present repeat unit of claims 14 and 18 which is derived from a polycyclic ethylenically unsaturated compound.

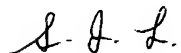
Yabuuchi does not teach or suggest present process of claim 24.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333.

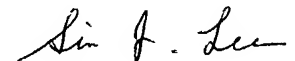
The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Lee
August 21, 2004



Sin J. Lee
Patent Examiner
Technology Center 1700